

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

**In re application of:
Jacqueline Evynne Breuninger Buskop**

Group Art Unit: 3677

Serial Number: 10/675,515

Examiner: Reese, David C

Filed: 09/30/2003

Confirmation Number: 6098

**For: ADVERTISING DEVICE FOR
PRODUCE AND CANDY VENDORS**

Attorney Docket Number: 1207.01A

Mail Stop Appeal Brief - Patent
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPELLANT'S BRIEF ON APPEAL

This brief is in furtherance of the Notice of Appeal and Pre-Appeal Brief Request for Review filed on April 14, 2008.

If an extension of time is required to enable this paper to be timely filed, this paper is to be construed as also constituting a Petition for Extension of Time under 37 CFR § 1.136(a) for a period of time sufficient to enable this document to be timely filed.

The Commissioner is authorized to deduct the fee for filing this Appeal Brief (\$255) from **Buskop Law Group P.C., Deposit Account No. 50-1313**. No other fee is believed to be due in connection with the filing of this document. However, should any other fee be deemed necessary for any other reason relating to this document, the Commissioner is hereby authorized to deduct said fee from **Buskop Law Group Deposit P.C., Account No. 50-1313**.

I. REAL PARTY IN INTEREST

The present application is owned by Jacqueline Evynne Breuninger Buskop.

II. RELATED APPEALS AND INTERFERENCES

Appellant is not aware of any related appeals and/or interferences that might affect the outcome of this proceeding.

III. STATUS OF CLAIMS

Claims 1, 5, 7-9, and 13 remain pending in this application.

Claims 1 and 8 have been rejected under 35 USC §112, first paragraph.

Claims 1, 5, and 7 stand rejected under 35 USC § 103(a) as being unpatentable over *Westmoland* (US 5,201,578), in view of *Bradley* (US 2,180,726), and in further view of case law.

Claims 8, 9, and 13 stand rejected under 35 USC § 103(a) as being unpatentable over *Westmoland* (US 5,201,578), in view of *Bradley* (US 2,180,726), in view of *Johnson* (US 6,619,816), and in even further view of case law.

Claims 1, 5, 7-9, and 13 are listed in the Claims Appendix.

IV. STATUS OF AMENDMENTS

An amendment, response, and request for continued examination were filed on October 19, 2007, to address the rejections made by the Final Office Action dated August 10, 2007.

As indicated in the Office Action mailed January 16, 2008, Appellant's submission filed on October 19, 2007, was entered.

Appellant believes that the Claims as presented are in proper form for allowance.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Claim 1 and Claim 8, are directed to an advertising device for produce vendors, and an advertising device for candy vendors, respectively.

Each device includes at least one earring clip with a back side and front side for engaging a non-pierced ear (Page 2, Paragraph [00011], Lines 18-19; and Figures 1 and 2, Reference Numbers 10, 11, and 13).

At least one line is axially secured to the earring clip (Page 3, Paragraph [00018], Lines 25-26; and Figure 3, Reference Number 19).

A first hook and a second hook are axially secured to the line (Page 2, Paragraph [00011], Lines 19-20; Page 3, Paragraph [00012], Lines 1-2; and Figure 3, Reference Numbers 12 and 24). The hooks are axially aligned with each other (Figure 3, Reference Numbers 12 and 24).

The first hook has at least a first prong and a second prong for engaging at least a first of the edible food items, and the second hook has at least a third prong and a fourth prong for engaging at least a second of the edible food items (Page 3, Paragraph [00014], Lines 11-14; and Figure 2, Reference Numbers 22, 24, 14a, and 14b).

At least a first of the edible food items is removably secured to the first hook by at least partially penetrating the first edible food item, and at least a second of the edible food items is removably secured to the second hook by at least partially penetrating the second edible food item (Page 3, Paragraph [00015], Lines 15-16; Page 3, Paragraph [00016], Line 22; and Figure 2, Reference Numbers 14, 14a, and 14b).

The edible food items consist of chewy candy, fruits, vegetables, or combinations of these items (Page 3, Paragraph [00015], Lines 15-18; and Page 3, Paragraph [00017], Lines 23-24).

An automatic LED is disposed on a lower portion of the front side for lighting the different edible food items (Page 3, Paragraph [00013], Lines 4-5; and Figure 2, Reference

Number 16).

The automatic LED is electrically insulated from the earring clip (Page 3, Paragraph [00013], Lines 3-4; and Figure 2, Reference Numbers 10 and 16 – It is inherent that the earring clip 10 for a non-pierced ear will not create a complete circuit to conduct power to the LED 16, and therefore, the LED 16 must have its own circuitry that is insulated from the earring clip 10 in order to function properly).

The automatic LED is a blinking light that can be actuated by a switch secured to the earring clip (Page 3, paragraph [00013], Lines 5-6; and Figure 2, Reference Number 20).

VI. GROUNDS FOR REJECTION TO BE REVIEWED ON APPEAL

1. Whether Claims 1 and 8 are properly rejected under 35 USC 112, first paragraph.
2. Whether Claims 1, 5, and 7 are patentable over *Westmoland* (U.S. 5,201,578), in view of *Bradley* (U.S. 2,180,726), in further view of case law.
3. Whether Claims 8, 9, and 13 are patentable over *Westmoland* (U.S. 5,201,578), in view of *Bradley* (U.S. 2,180,726), in view of *Johnson* (U.S. 6,619,816), and in even further view of case law.

VII. ARGUMENT

35 U.S.C. §112 REJECTIONS OF CLAIM 1 AND CLAIM 8

Appellant contends that the rejections of Claims 1 and 8 under 35 U.S.C. §112, first paragraph, should be reversed.

The recitation “a pair of earrings” is taught by Appellant’s disclosure

Appellant believes that the recitation, “a pair of earrings” is not new matter, as suggested by the Examiner.

Appellant believes that one skilled in the art of jewelry would understand Appellant’s disclosure to teach a pair of earrings, since earrings are conventionally worn as a pair. Additionally, Appellant references use of “earrings” in Paragraphs [0003] and [00018] of Appellant’s Specification, as filed.

A specification complies with the 35 USC §112, first paragraph, written description requirement if it conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, the inventor was in possession of the invention. *Ex parte Hans-Gerd Brunneke*, 2008-1120 (BPAI 6/10/2008) (citing *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-65 (Fed. Cir. 1991)).

Therefore, Appellant believes “a pair of earrings” does not constitute new matter, and Appellant’s initial disclosure reasonably conveys to one skilled in the relevant art that the present advertising device includes a “pair” of earrings.

The recitation that the automatic LED is “electrically insulated from the at least one earring clip” is taught by Appellant’s disclosure

Appellant believes that the recitation that the automatic LED is “electrically insulated from the at least one earring clip” is not new matter, as suggested by the Office Action.

Appellant's Figure 2 depicts a LED light 16 secured to an earring clip 10. The earring clip 10, hooks 12 and 15, prongs 22 and 24, and edible items 14, 14a, and 14b, as shown, do not form a complete circuit capable of conducting power to the LED light 16. (Appellant's Paragraph [00013] and Figure 2)

Therefore, Appellant's LED light 16 must inherently include circuitry that is insulated from the earring clip 10. Without such electrical insulation, the LED light 16 would be unable to operate as intended.

Information contained in any one of the specification, claims, or drawings of the application as filed may be added to any other part of the application without introducing new matter. MPEP §2163.06 and *Ex Parte Hans-Gerd Brunneke*, supra, page 5 (reversing a §112, first paragraph rejection due to the disclosure of a figure enabling a rejected claim).

There is no *in haec verba* requirement for supporting newly added claim limitations; newly added claim limitations may be supported in the specification through express, implicit, or inherent disclosure. MPEP §2163.

In *Brunneke*, the Board reversed a rejection of eight claims under 35 USC §112, first paragraph. The *Brunneke* Examiner argued that the appellant's original disclosure lacked descriptive support for "a duct extending from said electrode to outside of said bearing shell," noting that in the text of the disclosure, the duct was not in the bearing shell, but rather in a ball and socket joint housing. The appellant argued that Figure 1 of the disclosure showed a portion of the duct at issue outside of the bearing shell, even though the related paragraph in the specification did not specifically reference a duct. The Board determined that the appellant's original disclosure showed possession of the duct, as claimed, and reversed the rejection.

Applying *Brunneke* and MPEP §2163, Appellant believes that the disclosure of Figure 2 shows possession of the automatic LED, electrically insulated from the earring clip, as claimed, independent of whether the text describing Figure 2 recites this limitation *in haec verba*.

One skilled in the relevant art would reasonably construe, from the implicit and inherent disclosures of Figure 2 and Paragraph [00013], that the LED light is electrically insulated from the earring clip.

Appellant's 5 elements of Claim 1 and Claim 8 are not taught by the combination of *Westmoland, Bradley, and Johnson*

Appellant teaches an advertising device having two hooks, axially aligned with each other, that are axially secured to a line that is secured to an earring clip, each hook having prongs for engaging edible food items for illumination by an automatic LED. The automatic LED is electrically insulated from the earring clip.

Specifically, Appellant teaches:

- 1) a first hook and a second hook axially secured to at least one line;
- 2) the first hook and the second hook axially aligned with each other;
- 3) use of the first hook and second hook for penetrating at least two edible food items;
- 4) an automatic LED; and
- 5) the automatic LED is electrically insulated from the earring clip.

A. The Office Action states that *Westmoland* does not teach first and second hooks axially secured to at least one line, and axially aligned with each other

Westmoland does not teach first and second hooks axially secured to at least one line, and axially aligned with each other, each having a first prong and a second prong for engaging at least two different edible food items that are partially penetrated by each hook. (See Office Action, mailed 01/16/2008)

Without hooks, prongs, and lines, the jewelry described by *Westmoland* is not suitable for use as an advertising device that retains edible food items by penetrating the food items with hooks. *Westmoland* describes purely ornamental jewelry, rather than an advertising device, as taught by Appellant.

B. Westmoland does not teach an automatic LED

Appellant's "automatic LED" is defined as:

"an LED light (16) secured to the earring clip that automatically lights up the hook (12) in dim light." (Appellant's Paragraph [00013])

Westmoland describes lighted or illuminated jewelry having "lighting elements 4," which can include LEDs. (*Westmoland*, Column 3, Lines 16-18) *Westmoland* does not teach an automatic LED.

In contrast, *Westmoland* describes insertion of a battery 3 between two plates 1, 2 to cause the lighting elements to be illuminated. (*Westmoland*, Column 4, Lines 55-66 and Column 5, Lines 15-36)

A finding of "obviousness requires a suggestion of all limitations in a claim," including Appellant's teaching of an automatic LED. *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) (citing *In re Royka*, 490 F.2d 981, 985 (CCPA 1974)); *In re Ochiai*, 71 F.3d 1456, 1572 (Fed. Cir. 1995).

Appellant's advertising device fore automatically conserves power in lighted conditions by remaining inactive, and can automatically illuminate attached edible food items in dim conditions, without requiring manipulation of switches or batteries, which can be tedious and difficult when an earring is being worn, and can generate additional expense.

C. Westmoland fails to teach that the LED is electrically insulated from the earring clip

Westmoland describes a jewelry item that "itself is part of an electrical circuit." (*Westmoland*, Column 1, Lines 5-8)

Westmoland teaches a lighting element having electrically conductive leads is connected to the jewelry body, which includes plate members spaced apart with electrically conductive

means, and a battery sized to fit between the plate members. (*Westmoland*, Column 1, Lines 30-43) The assembly of the jewelry completes an electrical circuit. (*Westmoland*, Column 1, Lines 43-48) The plates of the jewelry body are formed from an electrically conductive material to which a battery and lighting elements are directly attached. (*Westmoland*, Column 3, Lines 27-35)

Westmoland does not teach a LED that is electrically insulated from the earring clip.

Appellant defines the term “earring clip”, depicted as element 10 in Appellant’s Figures 1 and 2, to include not only the front side 13 and back side 11 that secure the advertising device to the ear, but also the earring body. (Appellant’s Paragraph [00011] and Figures 1 and 2)

The “earring clip,” as defined by Appellant, applied to the jewelry of *Westmoland*, would include not only the spring earring clip attachment 10, but also the plates 1, 2, and the battery 3, which form the earring body.

In contrast, the plates of *Westmoland* are specifically intended to function as conductors for power between the battery and the LED, while Appellant’s earring clip 10 is instead insulated from the automatic LED.

In *Ex parte Boyd Clark Wade and Jimmy H. Torbett*, 2008-1120 (BPAI 6/25/2008), the Board reversed the final rejection of seven claims, the issue turning on the definition of the term “survey rod.” The *Wade* Examiner construed the term “survey rod” to be a thin straight piece or bar of material of a size and shape that would facilitate surveying. The appellants contended that those skilled in the art would define the term “survey rod” differently, in light of the specification.

The Board stated that the scope of the claims in patent applications is not determined solely on the basis of claim language, but upon giving claims “their broadest reasonable interpretation *consistent with the specification*” and “in light of the specification as it would be interpreted by *one of ordinary skill in the art*.” *Id* (citing *In re Am. Acad. Of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004)). Based on the disclosure of the appellants’ specification, the Board held that the specification clearly defined the survey rod in such a manner that those skilled in the art would understand the survey rod as described by the appellants in their brief.

The specification is the “single best guide” to claim construction, and the construction of claims must be construed from the viewpoint of one having ordinary skill in the art “on a reading of the patent documents,” including the specification. *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (reaffirming *Markman v. Westview Instruments, Inc.*, 52 F.3d 967 (Fed. Cir. 1995) and *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576 (Fed. Cir. 1996)).

Applying both *Wade* and *Phillips* to the instant application, Appellant’s Paragraph [00011] and Figures 1 and 2, define “earring clip” to include the entire depicted part labeled as element 10, namely the front side 13, back side 11, and structure of the earring body.

As such, Appellant’s limitation “wherein the automatic LED is electrically insulated from the earring clip” includes that the automatic LED is electrically insulated from the entirety of the earring clip 10.

Westmoland fails to teach an “earring clip,” as the structure of the earring body, that is electrically insulated from the automatic LED.

D. *Bradley* does not add the elements of Claim 1 and Claim 8 not taught by *Westmoland*

Appellant teaches a first hook 12 and a second hook 24, axially aligned with a line 19. (Appellant’s Figure 3 and Paragraph [00018])

Appellant uses the term “axially” with its common meaning to one skilled in the art: “Relating to, characterized by, or forming an axis.” (See e.g. <http://www.thefreedictionary.com/axially>)

Bradley describes attaching a clip 11 perpendicularly, rather than axially, to a link of chain 10 using a bifurcated element 15, having an aperture 14 through which the link of chain can extend, similar to hanging a charm from a necklace or bracelet. (*Bradley*, Column 2, Lines 27-32)

Conversely, Appellant’s line, first hook, and second hook are characterized by and define a vertical axis, along which the line, first hook, and second hook are positioned.

The jaws described by *Bradley*, which the Examiner interprets as hooks, are not axially aligned with the chain, which the Examiner interprets as a line, but instead hang perpendicularly from the chain. (*Bradley*, Column 2, Lines 27-32 and Figure 1)

Bradley describes two jaws, faced in opposition, rather than in axial alignment, like a clamp, operating similar to a pair of tongs to secure objects between piercing points.

The clip 11 described by *Bradley* includes two jaws 16, 17, which pivot about a pin 21, allowing the piercing points 22a of the jaws to be manually opened, while a coiled spring 23 retains the jaws in a closed position, similar in operation to a clamp or pair of tongs. (*Bradley*, Column 2, Lines 32-51 and Figures 2 and 3)

Appellant's arrangement of axially aligned hooks enables multiple edible food items to be displayed vertically, while providing a predictable distribution of weight directly beneath the earring clip. *Bradley*'s use of jaws and clips that are not axially aligned with the line or with one another is not suitable for retaining and displaying items having differing weights, which could cause an earring to become disengaged from the ear or to hang in an uncomfortable or aesthetically unappealing, lopsided manner.

Additionally, Appellant's axial arrangement of hooks enables Appellant's advertising device to secure one or more edible food items with a single hook, by penetrating the edible food items with prongs, while the jewelry described by *Bradley* uses two opposing jaws to grasp and retain objects in a desired position.

In *Ex parte Walker et al.*, 2007-4170 (BPAI 05/21/2008), the Board reversed a final rejection of forty claims. The cited reference disclosed a video poker machine with a selector button allowing the player to select from different payout tables at any time. The appellant argued that the cited reference, while allowing the player to select payout tables, did not teach appellant's step of making a determination whether to offer the player a choice to switch payout

tables, and simply offered the option at any time during play through the existence of the selector button.

Although the cited reference ostensibly accomplished the same result as the application at issue, it did so in a functionally different manner. As such, the Board held that the cited reference did not anticipate the claims at issue.

Applying *Walker* to the instant application, Appellant believes that the Examiner's interpretation of the clip described by *Bradley* as a hook is improper.

While the jaws described by *Bradley* have a curved shape and secure objects between piercing points, the jaws function using a coiled spring to retain two opposing jaws in a closed position on opposite sides of an object. Appellant's hooks function in a different manner, by penetrating edible food items with single prongs, thereby retaining the items in the manner of a hook, rather than a clip.

In light of *Walker*, Appellant believes that *Bradley* fails to teach use of hooks to secure edible food items, as taught by Appellant.

Also, *Bradley* does not teach use of any illuminating devices and instead describes only ornamental jewelry, without reference to such features.

Appellant's automatic LED enables Appellant's advertising device to illuminate and attract attention to displayed edible food items, thereby enabling Appellant's earrings to be useable as an advertising device, and not merely ornamental jewelry.

E. *Johnson* was cited to show use of candy with lighting elements and does not teach the elements of Claim 8 not taught by *Westmoland* and *Bradley*

Johnson describes a confection assembly, namely a lighted lollipop or similar candy item, having a light device, a light transmission element attached to the light device, and an edible confection attached to the light transmission element. (*Johnson*, Column 2, Lines 18-20)

Johnson does not teach use of hooks to secure the confection, but instead teaches a mounting hole 26 in the confection. (*Johnson*, Column 4, Lines 34-38 and Column 2, Lines 20-23)

Johnson thereby fails to teach use of first and second axially aligned hooks that are axially secured to at least one line, as taught by Appellant.

Also, although *Johnson* describes that the light device 16 can be configured to use standard incandescent bulbs, LEDs, or other suitable light generating mechanisms 22 (*Johnson*, Column 4, Lines 1-3), *Johnson* does not teach an automatic LED that “automatically lights up the hook (12) in dim light,” as taught by Appellant. (Appellant’s Paragraph [00013])

Johnson also does not teach an automatic LED light that is electrically insulated from an earring clip, as *Johnson* does not teach an earring clip or other comparable structure.

Johnson thereby fails to teach an automatic LED that is electrically insulated from an earring clip, as taught by Appellant.

The combination of useful elements for the novel marketing device of this now 11-year-old Applicant has not been taught by the references. She has had financial success in the marketplace with the present device, and desperately needs a patent issued to develop her business. Please help her!

For the reasons stated above, Appellant believes that the recitations “a pair of earrings” and “wherein the automatic LED is electrically insulated from the earring clip” do not constitute new matter, and the rejections under 35 USC §112, first paragraph, should be reversed.

Additionally, the rejections under 35 USC §103 should be reversed, as the combination of *Westmoland*, *Bradley*, and *Johnson* fails to teach:

- 1) a first hook and a second hook axially secured to at least one line;
- 2) the first hook and the second hook axially aligned with each other;
- 3) use of the first hook and second hook for penetrating at least two edible food items;
- 4) an automatic LED; and
- 5) the automatic LED is electrically insulated from the earring clip;

In view of the foregoing, it is respectfully submitted that the Examiner erred in not allowing all claims pending in the present application over the prior art of record. The undersigned attorney may be contacted at (713) 275-3400 with respect to any questions, comments, or suggestions in relation to this appeal.

Respectfully submitted,



Wendy Buskop
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CLAIMS APPENDIX

1. (Previously Amended) An advertising apparatus for produce vendors consisting of a pair of earrings, wherein each earring consists of:
 - a. at least one earring clip with a back side and a front side for engaging a non-pierced ear;
 - b. at least one line axially secured to the at least one earring clip, a first hook axially secured to at least one line; a second hook axially secured to the at least one line between the earring clip and the first hook, wherein the second hook is axially aligned with the first hook, and wherein the first hook and the second hook each have at least a first prong and a second prong respectively, for engaging at least two different edible food items;
 - c. wherein the at least two different edible food items are removably secured to each hook by at least partially penetrating the at least two different edible food items using each hook, and the at least two different edible food items are selected from a member of the group consisting of: a fruit, a vegetable, and combinations thereof; and
 - d. an automatic LED disposed on a lower portion of the front side for lighting the at least two different edible food items, wherein the automatic LED is electrically insulated from the at least one earring clip, and wherein the automatic LED is a blinking LED light that can be actuated with a switch secured to the at least one earring clip illuminating the at least two different edible food items.
2. (Cancelled)
3. (Cancelled)
4. (Cancelled)
5. (Previously Amended) The advertising apparatus of claim 1, wherein the first hook and the second hook are each between 1.5 inches and 3 inches in overall length.

6. (Cancelled)
7. (Previously Amended) The advertising apparatus of claim 1, wherein the at least one edible food item is selected from a member of the group consisting of: blueberries, strawberries, dried fruits, blackberries, cherry tomatoes, kiwi fruits, other fruits, other vegetables, and combinations thereof.
8. (Previously Amended) An advertising apparatus for candy vendors consisting of a pair of earrings, wherein each earring consists of:
 - a. at least one earring clip with a back side and a front side for engaging a non-pierced ear;
 - b. at least one line axially secured to the at least one earring clip; a first hook axially secured to the at least one line; a second hook axially secured to the at least one line between the at least one earring clip and the first hook, wherein the second hook is axially aligned with the first hook, and wherein the first hook and the second hook each have at least a first prong and a second prong respectively, for engaging at least two different chewy candy items;
 - c. wherein the at least two different chewy candy items are removably secured to each hook by at least partially penetrating the at least two different chewy candy items using each hook;; and
 - d. an automatic LED disposed on a lower portion of the front side for lighting the at least two different chewy candy items, wherein the automatic LED is electrically insulated from the at least one earring clip, and wherein the automatic LED is a blinking LED light that can be actuated with a switch secured to the at least one earring clip illuminating the at least two different chewy candy items.
9. (Previously Amended) The advertising apparatus of claim 8, wherein the at least one chewy candy item is selected from a member of the group consisting of: soft licorice, soft raspberries, juicy fruits, and combinations thereof.
10. (Cancelled)

11. (Cancelled)
12. (Cancelled)
13. (Previously Amended) The advertising apparatus of claim 8, wherein the first hook and the second hook are each between 1.5 inches and 3 inches in overall length.
14. (Cancelled)

Evidence Appendix

None

Related Proceedings Appendix

None